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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,261	10/10/2000	William Kenney	06975-029001	4267
26171	7590	10/17/2005	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			LY, ANH VU H	
			ART UNIT	PAPER NUMBER
			2667	

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/582,261	Applicant(s) KENNEY, WILLIAM	
	Examiner Anh-Vu H. Ly	Art Unit 2667	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-24 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>July 25, 2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This communication is in response to applicant's amendment filed July 25, 2005. Claims 1-24 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Britton et al (US Patent No. 6,442,577 B1). Hereinafter, referred to as Britton.

With respect to claims 1, 11, 16, and 22, Britton discloses in Fig. 1, a network system 100 includes users 120.1-120.P, organizations 114.1-114.K (terminal servers having a geographic location), and ICP 112.1-112.7 (host systems). Britton further discloses in Fig. 3, participant

database 300 for storing identification information for the ISP and organization nodes (a database). Britton discloses (col. 5, lines 1-7) that the organization node 114.2 forwards the service request, together with the IP address (terminal server identifier) (herein, the IP address corresponds to an assigned geographic location) assigned to the organization node 114.2, to the ICP node 112.2 via the Internet 110 (receiving at a host system, a terminal server identifier from a terminal server having a geographic location). Upon receiving the service request from the organization node 112.2, the HTTP server 113.2 in the ICP node 112.2 retrieves a home page and sends it to the organization node 114.2 via the Internet 110 (automatically sending the geographic location specific service data from the host system to the terminal server). Britton discloses in Figs. 3-6, different databases for matching the received IP address (herein, the IP address corresponds to an assigned geographic location) of the organizations (herein including the name of the organizations and locations of the organizations) to the customized web pages (querying a database to obtain service data associated with the geographic location of the terminal server based on the terminal server identifier).

With respect to claims 2-3, 14-15, and 17, Britton discloses in Figs. 3-6, different databases for matching the received IP address of the organizations (herein including the name of the organizations and locations of the organizations) to the customized web pages (wherein the database includes a first record that associates the terminal server identifier with the geographic location and querying the database includes determining the geographic location based on the terminal server identifier data from the first record and further wherein the database includes a record that associates the location with service data that is specific to the location, and querying

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the database further comprises determining the location specific service data based on the determined location).

With respect to claims 4 and 23, Britton discloses (col. 4, lines 64-67) that the internal user computer 102.2 sends a service request to the organization node 114.2 via the Intranet or local area network 116 (establishing a data connection between the terminal server and a client computer). Britton discloses (col. 5, lines 7-11) that upon receiving the homepage from the ICP node 112.2 (receiving the geographic location specific service data at the terminal server), the organization node 114.2 forwards the homepage to the internal user computer 120.2 via the Intranet or the local area network 116 (forwarding the geographic location specific service data from the terminal server to the client computer).

With respect to claim 5, Britton discloses (col. 4, lines 64-67) that the communication between the internal user computer and the organization node is established before the ICP receives the requested data (wherein establishing a data connection is carried out prior to receiving the terminal server identifier).

With respect to claim 6, Britton discloses (col. 4, lines 14-18) that the user computer 102.2 initiates a connection process (an example of which is a modem call via the public switched telephone network) to the ISP node 108.m via the connecting network 104 (wherein establishing a data connection further comprises receiving a dial-up modem connection from a client computer).

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With respect to claims 7, 12-13, 18, and 24, Britton discloses (col. 5, lines 1-7) that the organization node 114.2 forwards the service request, together with the IP address (terminal server identifier) assigned to the organization node 114.2, to the ICP node 112.2 via the Internet 110 (wherein the terminal server identifier comprises a network address associated with the terminal server).

With respect to claims 8 and 19, Britton discloses (col. 5, lines 1-7) that the organization node 114.2 forwards the service request, together with the IP address (terminal server identifier) assigned to the organization node 114.2, to the ICP node 112.2 via the Internet 110 (wherein receiving the terminal server identifier further comprises receiving a data packet from the terminal server, the data packet including the terminal server network address).

With respect to claims 9 and 20, Britton discloses (col. 4, line 62 – col. 5, line 4) that assuming the internal user computer wants to obtain web pages (information service) from the ICP node 112.2. The internal user computer sends a service request to the organization node 114.2. Upon receiving the service request from the internal user computer, the that the organization node 114.2 forwards the service request, together with the IP address (terminal server identifier) assigned to the organization node 114.2, to the ICP node 112.2 via the Internet 110 (wherein the data packet includes request data received at the terminal server from the client computer, the request data identifying an information service).

With respect to claims 10 and 21, Britton discloses in Figs. 3-6, different databases for matching the received IP address of the organizations (herein including the name of the organizations and locations of the organizations) to the customized web pages (wherein querying the database comprises querying based on the terminal server identifier and the request data; and the geographic location specific service data obtained by the query of the database is associated with both the terminal server identifier data and with the service identified by the requested data).

Response to Arguments

3. Applicant's arguments filed July 25, 2005 have been fully considered but they are not persuasive.

Applicant argues in page 1 that Britton fails to describe or suggest a terminal server having a geographical location and a database that is queried to obtain service data associated with the geographic location of the terminal server based on the terminal server identifier. Applicant further states, pages 1-2, that according to Britton, upon receiving a request for data from a particular IP address, the ICP captures the IP address and compares it against IP addresses stored in a participant database. The ICP then finds the name of the organization in the participant database and looks up associated information based on the organization name. Further, based on the organization name, Britton then suggests delivery of a webpage containing customized advertising content. Applicant furthermore states that Britton fails to determine the geographic location of the terminal server from which the request is received. Britton does not maintain or track any information related to a geographic location. And Britton fails to disclose

a database that is queried to obtain service data associated with the geographic location of the terminal server.

Examiner respectfully disagrees. First of all, it should be understood that an IP address is like a telephone number that identifying who and where you are. Therefore, upon receiving a request for data from a particular IP address, that IP address is then compared against IP addresses stored in a database, and associated information is delivered. Herein, the IP address is indirectly used to look up associated information. Therefore, Britton discloses that a terminal server having a geographic location and a database that is queried to obtain service data associated with the geographic location of the terminal server based on the terminal server identifier.

Applicant further argues in page 2 that an IP address itself does not contain any geographic information. Examiner respectfully disagrees. An IP address identifies who you are and where you are from. Therefore, it contains geographic information regarding the user. For further information, please see RFC 1918 IP address.

Applicant argues in page 3 that applicant's claimed association of a terminal server identifier with a particular geographic location enables delivery of content that is localized and thus geographically relevant to the recipient. Examiner has carefully reviewed independent claims and found no such argued limitations, e.g., "delivery of content that is localized and thus geographically relevant to the recipient".

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh-Vu H. Ly whose telephone number is 571-272-3175. The examiner can normally be reached on Monday-Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham can be reached on 571-272-3179. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

avl


CHI PHAM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2000 10/13/05